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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,722	08/18/2003	Chon-Chen Lin	T-1250	4696
802	7590	05/05/2005	EXAMINER	
DELLETT AND WALTERS			HUNTER, ALVIN A	
P. O. BOX 2786			ART UNIT	
PORTLAND, OR 97208-2786			PAPER NUMBER	

3711

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/643,722

Applicant(s)

LIN, CHON-CHEN

Examiner

Alvin A. Hunter

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 3-8 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I and Species I in the reply filed on November 30, 2004 is acknowledged.

Claims 3-8 and 10 directed to non-elected inventions and species has been withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helmstetter et al. (USPN 6565452) in view of Willett et al. (USPN 6773360).

Regarding claim 1, Helmstetter et al. discloses a club head having a striking plate **60** made of a light metal alloy, having a front **72**, rear, toe **82**, heel **80**; shank **54** formed at the heel, and a rim **76** and **78** formed around the rear of the striking plate to form a hollow cup-like body, the body **61** bonded to the rim and being composed of crown **62** and sole **64** made of a fiber pre-preg material, and a sole plate **95** made of metal and mounted in the sole (See Abstract, Figure 7, and the Summary of the Invention).

Helmstetter et al. discloses the club head being weighted and that the weight may be placed in other locations of the club head in order to influence the center of gravity but does not disclose the club head having a seat and hole in the sole and a balanced

Art Unit: 3711

weight attached through the hole. Willet et al. discloses a club head having a seat and a hole through the sole wherein a balance weight is attached through the hole (See Abstract). Willet et al. discusses the need to fine tune the weight of the club head and lower the center of gravity of the club head (See Background of the Invention). One having ordinary skill in the art would have found it obvious to have a seat and a hole in the sole and a balance weight attached through the hole of Helmstetter et al., as taught by Willet et al., in order to lower the center of gravity of the club head.

Regarding claim 2, Helmstetter et al. discloses the body made of carbon fiber pre-preg material based on the incorporation of U.S. Patent 6,248,025 into the disclosure (See Column 10, lines 28 through 45).

Claims 1, 2, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beach et al. (USPN 6872152) in view of Willett et al. (USPN 6773360).

Beach et al. discloses a club head having a striking plate **12** made of a light metal alloy, having a front, rear, toe, heel, shank **16** formed at the heel, and a rim formed around the rear of the striking plate to form a hollow cup-like body, the body **20** bonded to the rim and being composed of crown **30** and sole **28** made of a fiber pre-preg material, and a sole plate **32** made of metal and mounted in the sole (See Abstract, Figure 1, and Column 3, line 38, to Column 4, line 7). Beach et al. does not disclose the club head having a seat and hole in the sole and a balanced weight attached through the hole. Willet et al. discloses a club head having a seat and a hole through the sole wherein a balance weight is attached through the hole (See Abstract). Willet et al. discusses the need to fine tune the weight of a club head and lower the

Art Unit: 3711

center of gravity of the club head to suit the user's need (See Background of the Invention). One having ordinary skill in the art would have found it obvious to have a seat and a hole in the sole and a balance weight attached through the hole of Beach et al., as taught by Willet et al., in order to lower the center of gravity of the club head.

Regarding claim 2, Beach et al. discloses the body made of carbon fiber pre-preg material (See Column 3, lines 49 through 53).

Regarding claim 9, Beach discloses the sole having an opening wherein the sole plate is mounted therein (See Figure 1).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3 of U.S. Patent No. 6805643. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application does not claim an inner plate

Art Unit: 3711

attached to the striking plate. Though this is not claimed in the instant application, U.S. Patent No. 6805643 anticipates the instant claim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAH

Alvin A. Hunter, Jr.


GREGORY VIDOVICH
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